

REMARKS

Reconsideration of the present application is respectfully requested. Independent claims 1, 10, and 13, and dependent claims 2, 8, 9, 15, 18 and 19 have been amended. Claims 3, 4, and 16 have been canceled. Claims 1, 2, 5-15, and 17-21 remain pending in this application. No new matter has been added.

Claim Objections

The Office Action objects to the form of claims 8,9,18 and 19 asserting that the submitted dependant claims are actually independent claims that attempt to incorporate other limitations of other dependent claims. Claims 8, 9, 18 and 19 have been amended to more clearly indicate that they depend from the entire method of their respective base claims, rather than the steps they recite.

As amended, claims 8,9,18 and 19, as amended, are in proper dependent claim format. A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. 35 U.S.C. §112 ¶4. The aforementioned claims each reference a claim previously set forth. Claims 8, 9, 18 and 19 are written in a format that defines, in dependent form, an embodied computer program that performs a method, defined by claims 1 and 17, respectively.

Second, the format of claiming a computer-readable medium with instructions to perform a method, or a computer programmed to perform the method, was approved in *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). The primary difference between the *Beauregard* claims and claims 8,9,18 and 19 is that these claims depend from a base claim that is a process claim. This format may raise an initial concern because the preamble of the dependent claim differs from that of the base claim. However, dependent claims with preambles that differ from their base claim are not objectionable solely for that reason. The Board of Patent Appeals and Interferences expressed this holding in *Ex parte Adrianus P.M.M. Moelands*, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987). In *Moelands*, the Board upheld as appropriate the following dependent claim to a data transmission system:

*11. A data transmission system comprising:
at least two of the data transmission stations of claim 10;
a clock bus interconnecting the clock terminals of the stations; and
means which maintain the clock bus at the second voltage level in the absence of
forcing by the stations.*

Although the preamble in *Moelands'* claim 11 to a "data transmission system" is different than the preamble in claim 10 to a "data transmission **station**", the Board held that this dependent claim format satisfies the statutory requirements of both the second and fourth paragraphs of 35 U.S.C. §112.

Third, a claim, such as claims 8,9, 18 and 19, reciting a computer readable medium encoded with a computer program is statutory subject matter and is treated as a product claim. MPEP §2106(IV)(B)(1)(a). As amended, claim 8 recites: "A computer readable medium having computer executable instructions for performing the method of claim 1." Similar language appears in claim 18, which depends from claim 17. Claim 9 recites "A computer system having a processor, a memory and an operating environment, the computer system operable to perform the method of claim 1." Again, similar language appears in claim 19, which depends from claim 17.

Fourth, a dependent claim is not per se improper merely because it is drawn to different statutory class than its corresponding base claim (i.e. an independent method claim with a dependent apparatus claim), . MPEP §608.01(n)(III); MPEP §806.05(e). Claims 1, 8, 18, and 19 are in the statutory class of manufacture (or "product") claims, and depend from independent method claims 1 and 13.

Fifth, dependant claims that cross statutory classes are not per se objectionable. A claim in have a format of "a computer readable media . . . for performing the method of claim X" is analogous to a product-by-process claim, which relates to more than one statutory class of invention (namely, process & article of manufacture). Product-by-process claims cross statutory claim classes but are not objectionable merely because they do. *See* MPEP 2173.05(p). Claims 8, 9, 18 and 19 are similar to a product-by-process claim in that they define an embodied computer program that is executable on a computer to perform the methods set forth in claims 1 and 17, respectively. The

methods are physically embodied in a computer program encoded on one or more computer-readable media. Claims 8, 9, 18 and 19 are proper in their construction in that they reference and are dependent from claims 1 and 17, and define the product as having embodied thereon the methods in claims 1 and 17. Moreover, the metes and bounds of claims 8, 9, 18 and 19 are clearly set forth in the methods of claims 1 and 17, from which claims 8-9 and 18-19 respectively depend.

Sixth, this type of dependent- *Beauregard* claim format is ubiquitous, and widely appears in issued patents. In fact, a search of the USPTO database at <http://patft.uspto.gov/netahtml/search-bool.html> using “for performing the method of” (in quotations) as a query term for the “Claim(s)” field, returns **2,041** results as of Nov. 5, 2004. Arbitrarily picking the first patent (which happens to be U.S. No. 6,813,762), one notes claim 17 and its format: “17. A **semiconductor device** capable of performing the **method** of claim 1” Emphasis added.

Claim language very similar to amended claims 8, 9, 18 and 19 is common in this particular field of patents. Illustratively, similar claim language appears in the claims of U.S. Patent Nos. 6,810,291; 6,809,729; 6,808,248; 6,807,636; 6,807,548 and 6,807,546. For example, claim 19 of U.S. Patent No. 6,807,548 recites “A computer-readable medium having computer-executable instructions **for performing the method of claim 1**” emphasis added.

Accordingly, amended claims 8, 9, 18 and 19 are in condition for allowance because the claims are in proper dependent form. Applicant respectfully requests the objection to claims 8, 9, 18 and 19 be withdrawn.

Rejections Based on 35 U.S.C. § 102(e)

In the Office Action, claims 1-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 09/917,228 to Schwartz et al. (“*Schwartz*”). The foregoing rejections are respectfully traversed.

Independent claim 1 has been amended to include the features of “storing said one or more raw informational items in a temporary storage table”, “storing said derived version in a validation table”, and “validating said derived version against said raw informational items based on a comparison of said temporary storage and validation tables.” Independent claim 10 has been

amended to include the features of “said transferring component stores said one or more raw informational items in a temporary storage table”, “creating a derived version of said one or more informational items stored in said temporary storage table”, and “creating a validation table from said derived version and comparing said validation table to said temporary storage table.” Further, Independent claim 13 has been amended to include the features of “extracting data from said operational database tables to create a validation table” and “comparing said temporary storage table with said validation table.” Claim 20 includes the aforementioned features. Comparison of the aforementioned tables is used to validate data in the production store or operational tables. It is respectfully submitted that Schwartz does not teach the use of storing data in tables for purposes of comparison and validation. Schwartz does not teach or suggest the use of a temporary storage table for data in the remote patient database (raw data) to validate data used by the prediction program. Rather, Schwartz uploads the data in the remote patient database to the local patient database. A validation table is created based on information in the local patient database and is compared to information in the remote patient database (the raw data). Schwartz, paragraph 35. Thus, Schwartz does not disclose the step of creating a table comprising raw data for validating data used by the prediction program.

Accordingly, independent claims 1, 10, 13, and 20 are in condition for allowance. Furthermore, dependant claims 2, 5-9 depend from independent claim 1, and are consequently in condition for allowance because they include each limitation of claim 1. Dependent claims 11 and 12 depend from independent claim 10, and are consequently in condition for allowance because they include each limitation of claim 10. Further, dependent claims 14 and 17-19 depend from claim 13, and are consequently in condition for allowance because they include each limitation of claim 13. Finally, dependent claim 21 depends from independent claim 20, and is likewise in condition for allowance because it includes each limitation of claim 20.

Conclusion

Schwartz does not teach or suggest the claimed invention. For the reasons stated above, claims 1, 2, 5-14, and 17-21 are in condition for allowance. Applicant respectfully request withdrawal of the pending rejections and a Notice of Allowance be issued in this case. If any issues

Application No. 10/054,052
Amendment dated November 16, 2004
Reply to Office Action of August 19, 2004

remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The commissioner is hereby authorized to charge any additional amount required, or credit any over payment, to deposit account No. 21-0765.

Respectfully submitted,



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